

REMARKS:

The claims pending in the subject patent application have been subjected to a restriction requirement under 35 U.S.C. §121. During a telephone conversation with the Examiner on April 23, 2003, a provisional election was made to prosecute the invention of Group I which is directed to claims 1-20 and 29. In affirmation of this election the non-elected claims (claims 21-28) have been canceled.

Claims 3, 4, 7, 8, 13, 15, 17, and 29 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that the applicants regard as being their invention. In response to this rejection, claims 3, 4, 7, 8, 13, 15, 17, and 29 have been amended in the manner suggested by the Examiner.¹

Claims 1-20 and 29 have been rejected under 35 U.S.C. §103(a) as being unpatentable over the teachings of Halasa et al (United States Patent 6,103,842) in view of Chem. Abstract 76:155173, referencing Fujioet et al, Nippon Kagaku Kaishi, vol. 2, pp 447-453, (1972). Under 35 U.S.C. §103(c), Halasa cannot be used in supporting a rejection under 35 U.S.C. §103(a). More specifically, 35 U.S.C. §103(c) reads as follows:

“Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.”

35 U.S.C. §103(c) applies to any patent application filed on or after November 29, 1999. The subject patent application was filed on November 7, 2001. Thus, 35 U.S.C. §103(c) applies to the subject patent application. The invention of Halasa and the invention being claimed in the subject patent application were commonly owned, or under an obligation of assignment to the same person, at the time the invention was made. This is evidenced by

¹ Claims 13, 15, and 17 have been amended so as to replace the term “alcoholate” with the preferred term “alkoxide.” Claims 3 and 7 have been amended so as to replace the term “alkyl lithium” which lacks a proper antecedent basis with the term “organolithium” which has an antecedent basis in claim 1. Claims 4, 8, and 29 have also been amended in the manner suggested by the Examiner.

the fact that both inventions have been assigned to The Goodyear Tire & Rubber Company. Halasa identifies The Goodyear Tire & Rubber Company as the assignee on its face and the assignment of Halasa to Goodyear is recorded in the PTO. A copy of the assignment of the subject patent application to Goodyear is being submitted herewith as Exhibit A. Thus, Halasa does not qualify as prior art under 35 U.S.C. §102(e), 35 U.S.C. §102(f), or 35 U.S.C. §102(g). Furthermore, none of the other subsections of 35 U.S.C. §102 can be used to support a rejection made under 35 U.S.C. §103.

Halasa is not prior art that can be used to support a rejection under 35 U.S.C. §102(a)/103. The patent application on which the Halasa patent was based was pending from May 4, 1998 until August 15, 2000. During the pendency of an application, the information contained in that application is considered confidential. Under 35 U.S.C. §122, patent applications are secret documents. More specifically, 35 U.S.C. §122 reads as follows:

“...applications for patents shall be kept in confidence by the Patent and Trademark Office...”

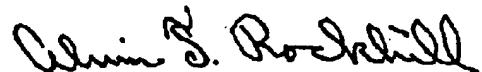
Accordingly, the Halasa patent application could not be deemed to be prior art under 35 U.S.C. §102(a)/103 and cannot support a rejection predicated on obviousness established by 35 U.S.C. §102(a)/103 because the teachings of Halasa were not available to the public until after the priority date of the subject patent application (October 1, 1998).²

Halasa is not prior art that can be used to support a rejection under 35 U.S.C. §102(b)/103 because Halasa was not issued (patented or published) more than one year prior to the priority date of the subject patent application. The subject patent application has an effective priority date of October 1, 1998, which is actually before the issue date of Halasa (August 15, 2000). Thus, the teachings of Halasa cannot be used to support any rejection made under 35 U.S.C. §102(b)/103.

² The subject patent application claims the priority of United States Patent Application Serial No. 09/389,507, filed on September 3, 1999 (now issued as United States Patent 6,359,088) which further claims the benefit of the filing date of United States Provisional Patent Application Serial No. 60/102,706, filed on October 1, 1998.

The subject patent application is now fully in compliance with the requirements of both 35 U.S.C. §103 and 35 U.S.C. §112. It is accordingly now appropriate to allow the subject patent application and such an allowance is respectfully requested.

Respectfully submitted,



Attorney for Applicant(s)

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EXHIBIT A

Docket No. DN1998179 DOSerial No. 101007,474Filed 11/07/2001

ASSIGNMENT

WHEREAS, WE, Adel Farhan Halasa, Wen-Liang Hsu and John Robert Zuppo III of 5040 Everett Road, Bath, Ohio 44333; 2034 Bent Creek Trail, Cuyahoga Falls, Ohio 44223; and 406 Sumner Street Apt A13, Akron, Ohio 44304 have invented certain improvements in CALCIUM-BASED CATALYST SYSTEM, and described in a patent application executed the 3rd day of September 1999, by the undersigned for filing in The United States of America, being owner(s) of all right, title and interest in and to said application and in and to any invention described therein and having full right to convey the entire interest both legal and equitable herein assigned; and

WHEREAS, THE GOODYEAR TIRE & RUBBER COMPANY, of Akron, Ohio 44316, a corporation of the State of Ohio (assignee) is desirous of acquiring the entire right, title and interest in and to said application and said invention described therein and any and all patents to be obtained therefor, all as hereinafter set forth:

NOW, THEREFORE, in consideration of good and valuable consideration received by the undersigned, the undersigned does (do) hereby sell, assign, transfer and set over unto said assignee, its successors and assigns, the entire right, title and interest in and to said invention or inventions, as described in the aforesaid application, in any form or embodiment thereof, and in and to the aforesaid application; and in and to any application filed in any foreign country based thereon, including the right to file said foreign applications under the provisions of the International Convention; also the entire right, title and interest in and to any and all patents or reissues or extensions thereof to be obtained in this or any foreign country upon said invention or inventions and any divisional, continuation, continuation-in-part or substitute applications which may be filed upon said invention or inventions in this or any foreign country; and the undersigned hereby authorize(s) and request(s) the issuing authority to issue any and all patents on said application or applications to said assignee or its successors and assigns.

The undersigned further agree(s) to execute all divisional, continuing, substitute, improvement, extension, reissue and other patent applications in this or any foreign country relating to said application or invention and to sign all other lawful papers and to perform all other lawful acts without further consideration, but without expense to myself (ourselves), which the assignee may deem necessary or desirable to make this Assignment fully effective including by way of example, but not of limitation, the following acts:

- (1) Prompt execution of all lawful oaths, affidavits and/or supplemental oaths required or deemed advisable by the assignee to further the prosecution of any application or applications for letters patent relating to the subject matter of this Assignment;
- (2) To co-operate to the best of my (our) ability in the execution of all lawful documents, the production of evidence, and the giving of testimony in interference, opposition, nullification or infringement proceedings involving the said invention or improvement, applications or patents or any of them.

The undersigned hereby authorize(s) said assignee to insert in this Assignment the serial number and filing date of the above-identified application when known.

IN WITNESS WHEREOF, the undersigned has (have) hereunto set his (their) hand(s) and seal(s) on the date(s) set after his (their) signature(s).

Elwin Rockhill (L.S.) Adel Farhan Halasa, Sept 3 19 99
WITNESS Adel Farhan Halasa

Elwin Rockhill (L.S.) Wen-Liang Hsu, Sept 3 19 99
WITNESS Wen-Liang Hsu

Elwin Rockhill (L.S.) John Robert Zuppo III, Sept 3 19 99
WITNESS John Robert Zuppo III

State of Ohio)
)
) SS:
County of Summit)

On this 3rd day of September 1999, before me personally appeared Adel Farhan Halasa to me personally known, and known to me to be the person(s) who signed the foregoing assignment, and acknowledge the signing of same as his (their) free act and deed.

Kristen Hovater

Notary Public

KRISTEN L. HOVATER, Notary Public
Residence - Summit County
State Wide Jurisdiction, Ohio
My Commission Expires May 1, 2000

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CENTRAL FAX CE.

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OFFICIAL

State of Ohio)
)
) SS:
County of Summit)

On this 3rd day of September 1999, before me personally appeared Wen-Liang Hsu to me personally known, and known to me to be the person(s) who signed the foregoing assignment, and acknowledge the signing of same as his (their) free act and deed.

Kristen Hovater

Notary Public

KRISTEN L. HOVATER, Notary Public
Residence - Summit County
State Wide Jurisdiction, Ohio
My Commission Expires May 1, 2000

State of Ohio)
)
) SS:
County of Summit)

On this 3rd day of September 1999, before me personally appeared John Robert Zuppo III to me personally known, and known to me to be the person(s) who signed the foregoing assignment, and acknowledge the signing of same as his (their) free act and deed.

Kristen Hovater

Notary Public

KRISTEN L. HOVATER, Notary Public
Residence - Summit County
State Wide Jurisdiction, Ohio
My Commission Expires May 1, 2000